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Docket No.: 02849/000G277-US0
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Clifford C. Thompson

Application No.: 09/454,770

Confirmation No.: 4218

Filed: December 3, 1999

Art Unit: 3639

For: RESIDENTIAL AND BUSINESS LOGISTICS
SYSTEM & METHOD

Examiner: A. Robinson-Boyce

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of a Notice of Appeal, and in accordance with the Pre-Appeal Brief Conference Pilot Program, Applicant hereby requests a pre-appeal brief review of the rejection mailed June 20, 2005 and the Advisory Action mailed August 11, 2005 in the above-identified application. No amendments are being filed with this request.

Claims 1-10 are pending in the application.

The sole question on appeal is whether the rejection of all claims as being obvious under 35 U.S.C. § 103(a) is correct. *See Advisory Action* mailed on **August 11, 2005, Continuation Sheet**.

Applicant submits that the method claims are rejected in error.

First, the proposed combination does not meet claim limitations. *See arguments of record* under that same heading, included in Applicant's **Response After Final Office Action**, filed on

July 25, 2005, at **pages 5-8**. As demonstrated at **pages 5-8** of Applicant's prior submission, the cited documents concern disparate technologies:

- ☐ Sosan concerns a receptacle that must be opened using a code to provide access.
- ☐ Morello concerns an always-locked vending machine that reads codes from a surface of an already-inserted videocassette, which are of an entirely different character than used by Sosan, in order to register its return to the always-locked vending machine.

Neither document teaches the step of registering placement of an article "after the securing step," nor does the combination fairly suggest use of codes to open a secure receptacle and register the placement of an article after securing the receptacle. Consequently, only using applicant's disclosure as a guide would one of skill in the art be able to arrive at the claimed method. The teachings of the two cited documents do not suggest or even hint at the claimed methodology. Thus, the combination as proposed does not teach or suggest all of the steps of claim 1, and therefore the Patent Office has not set forth a *prima facie* case of obviousness.

Second, the text of the **Advisory Action** (mailed on **August 11, 2005**) indicates that Examiner Robinson-Boyce has understood Applicant's argument; however, with due respect, the Examiner errs in contending that the "combination" of the two patents teaches the claimed steps. In making the proposed combination, the Patent Office is effectively asserting that it would have been obvious to try the steps recited in the claims; however, the references of record provide no motivation to combine them in the manner proposed. As noted above, the codes used by Sosan and Morello are for different purposes and different stages of a transaction and the fact that each

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Appl. No.: 09/454,770

Pre-Appeal Brief Request for Review Dated September 6, 2005

Reply to Office Action of June 20, 2005 and Advisory Action of August 11, 2005

document uses a code is not a sufficient basis for one of skill in the art to arrive at a completely different methodology in which a single code is used in a different way than taught or suggested by either reference. Thus, the Patent Office is relying on an incorrect standard of law, and the rejection should be withdrawn for that reason as well. Again, Applicant refers to its **Response After Final Office Action**, filed on **July 25, 2005**, at **pages 5-8**.

Applicant believes that claims 1-10 define patentably over the proposed combination of documents. Accordingly, Applicant requests that the present rejection be withdrawn and the claims be passed to allowance.

Dated: July 25, 2005

Respectfully submitted,

By 

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Appl. No.: 09/454,770

Pre-Appeal Brief Request for Review Dated September 6, 2005

Reply to Office Action of June 20, 2005 and Advisory Action of August 11, 2005